

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Jeffrey Aaron, et al.)
) Group Art Unit: 3625
Serial No.:	10/689,133)
) Examiner: Amee A. Shah
Filed:	October 20, 2003)
) Confirmation No: 2780
For:	METHOD, SYSTEM, AND STORAGE)
	MEDIUM FOR PROVIDING)
	AUTOMATED PURCHASING AND)
	DELIVERY)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

In response to the Final Office Action mailed May 12, 2008, and in conjunction with the concurrently filed Notice of Appeal, Applicants request a Pre-Appeal Conference in view of the following remarks.

REMARKS

In response to the final Office Action dated May 12, 2008, Applicants respectfully request reconsideration in a Pre-Appeal Brief Conference based on the following remarks. Reconsideration and allowance of the claims are respectfully requested in view of the following remarks.

Prior to discussing the rejections in detail, a summary of embodiments of the invention is provided. The claimed embodiments provided a method, system and storage medium for automatically executing a transaction on behalf of a network user. As shown in blocks 206-218 of Figure 2 and described in paragraphs [0023] – [0027] of Applicants' specification, the process automatically completes a transaction for a user based on user policies and rules. As described in Applicants' specification, the execution of a transaction may be purchasing a product or service on behalf of the user.

Claims 1-4, 6, 8, 9-13, 15, 17-22 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Miller in view of Giordano. This rejection is traversed for the following reasons.

Claim 1 recites, *inter alia*, "automatically executing the transaction on behalf of the network user." Neither Miller nor Giordano teaches or suggests this feature. Miller teaches distributing sales information to a user based on UPC information entered by the user. There is no teaching in Miller of automatically executing a transaction on behalf of the network user. The Examiner acknowledges that Miller does not teach automatically executing the transaction on behalf of the network user and relies on Giordano. Giordano teaches an e-commerce system in which previously purchased items are automatically placed in a user's online shopping cart (see Abstract). There is no teaching in Giordano that a transaction is completed automatically. In applying Giordano, the Examiner apparently reasons that placing items in the electronic shopping cart is a "transaction." Applicants respectfully disagree with this interpretation of "transaction."

As used in Applicants' specification, the transaction is a purchase of goods or services. Although claim 1 does not limit the transaction to a purchase, it is understood that a transaction is a dealing between two parties, with some consideration exchanged. If one walks into a store, places items in a cart and then decides to leave the store without the items,

then no transaction has taken place. This is precisely what Giordano teaches. Giordano automatically populates an online shopping cart, but does not automatically execute a transaction. In fact, Giordano teaches the opposite and requires that orders be “made by the user” (paragraph [0049]). Giordano does not teach “automatically executing the transaction on behalf of the network user” as alleged by the Examiner. Thus, even if Miller and Giordano are combined, the elements of claim 1 do not result.

For at least the above reasons, claim 1 is patentable over Miller in view of Giordano. Claims 2-4, 6, 8 and 9 depend from claim 1 and are patentable over Miller in view of Giordano for at least the reasons advanced with reference to claim 1. Independent claims 10 and 19 recite features similar to those discussed above with reference to claim 1 and are patentable over Miller in view of Giordano for at least the reasons advanced with reference to claim 1. Claims 11-13, 15, 17 and 18 depend from claim 10 and are patentable over Miller in view of Giordano for at least the reasons advanced with reference to claim 10. Claims 20-22 and 24 depend from claim 19 and are patentable over Miller in view of Giordano for at least the reasons advanced with reference to claim 19.

Claims 5 and 14 have been rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Miller in view of Giordano and Agrawal. This rejection is traversed for the following reasons.

Agrawal was relied upon for allegedly disclosing searching a service/product database to ensure that the items and services associated with the transaction are compatible with the transaction, but fails to cure the deficiencies of Miller in view of Giordano discussed above with reference to claims 1 and 10. Claims 5 and 14 depend from claims 1 and 10, respectively, and are patentable over Miller in view of Giordano and Agrawal for at least the reasons advanced with reference to claims 1 and 10.

Claims 7, 16, and 23 have been rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Miller in view of Giordano and Official Notice. This rejection is traversed for the following reasons.

Official Notice was relied upon for an application program interface, but fails to cure the deficiencies of Miller in view of Giordano discussed above with reference to claims 1, 10 and 19. Claims 7, 16 and 23 depend from claims 1, 10 and 19, respectively, and are

patentable over Miller in view of Giordano and Official Notice for at least the reasons advanced with reference to claims 1, 10 and 19.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicants' attorneys would be advantageous to the disposition of this case, the Examiner is cordially requested to telephone the undersigned.

In the event the Commissioner of Patents and Trademarks deems additional fees to be due in connection with this application, Applicants' attorney hereby authorizes that such fee be charged to Deposit Account No. 06-1130.

If any extensions of time are required under 37 C.F.R. 1.136, Applicants hereby petition for such extensions of time and authorize any extension fees to be charged to Deposit Account No. 06-1130.

Respectfully submitted,

By: 

David A. Fox
Registration No. 38,807
CANTOR COLBURN LLP
20 Church Street, 22nd Floor
Hartford, CT 06103-3207
Telephone (860) 286-2929
Facsimile (860) 286-0115
Customer No. 36192

Date: August 12, 2008